

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NAN-YAO SU

Appeal No. 1998-2893
Application 08/467,552

HEARED: July 10, 2001

Before CALVERT, FRANKFORT, and BAHR, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

REQUEST FOR REHEARING

Appellant has filed a request for rehearing of our decision of July 25, 2001 (Paper No. 40), in which we reversed the rejection of claims 1, 2, 5 to 9, 12 to 17, 19 to 23 and 25 to 28 under 35 U.S.C. § 103(a), and entered a new ground of rejection, pursuant to 37 CFR 1.196(b), of said claims under 35 U.S.C. § 102(b).

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In the request, appellant points out that on September 1, 1999, he filed a paper (Paper No. 27) withdrawing the appeal as to claims 1, 2, 5 to 7, 16, 17 and 19 to 21. This paper was inadvertently overlooked when our decision was rendered. Accordingly, the decision is vacated with regard to claims 1, 2, 5 to 7, 16, 17 and 19 to 21, which will be treated as provided in MPEP § 1215.03.

As to the remaining claims 8, 9, 12 to 15, 22, 23 and 25 to 28, the reversal of the rejection under § 103(a) and the new ground of rejection pursuant to 37 CFR 1.196(b) remain extant.

With regard to the new ground, appellant contends in essence that claims 8, 9, 12 to 15, 22, 23 and 25 to 28 are not anticipated by Takenaka, the reference applied under § 102(b), because, in addition to the toxin delivery housing disclosed by Takenaka, independent claims 8 and 22 both require a casing for defining a cavity in the ground. We agree. Since Takenaka does not disclose a casing as claimed, it cannot anticipate. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986)

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("absence from the reference of any claimed element negates anticipation"). The rejection is therefore withdrawn.

In summary, the request is granted to the extent that:
(1) the decision (Paper No. 40) is vacated insofar as it included any consideration of claims 1, 2, 5 to 7, 16, 17 and 19 to 21, the appeal as to those claims having been withdrawn;
(2) the examiner's decision to reject claims 8, 9, 12 to 15, 22, 23 and 25 to 28 under 35 U.S.C. § 103(a) remains reversed;
(3) the rejection under 35 U.S.C. § 102(b) pursuant to 37 CFR 1.196(b) is withdrawn.

GRANTED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
)	

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JENNIFER D. BAHR
Administrative Patent Judge

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